



Docket No.: 4838-001

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Is re Application of

Johann MÄNNER *et al.*

U.S. Patent Application No. 10/560,834

Filed: *December 15, 2005*

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:
: *Confirmation No. N/A*
:
: *Group Art Unit: N/A*
:
: *Examiner: N/A*

For: CELLULOSIC FIBRE OF THE LYOCCELL TYPE

TRANSMITTAL OF PRELIMINARY EXAMINATION REPORT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Attached is a copy of the Preliminary Examination Report regarding the above identified application.

Respectfully submitted,

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Date: January 3, 2007

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44*bis*)

| | | |
|--|--|---|
| Applicant's or agent's file reference L 380-7639/zi | FOR FURTHER ACTION | See item 4 below |
| International application No. PCT/AT2004/000441 | International filing date (<i>day/month/year</i>) 15 December 2004 (15.12.2004) | Priority date (<i>day/month/year</i>) 13 January 2004 (13.01.2004) |
| International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237 | | |
| Applicant LENZING AKTIENGESELLSCHAFT | | |

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|-------------------------------------|---|---|-----------|---------------------|--------------------------|------------|----------|--------------------------|-------------|--|--------------------------|------------|----------------------------|-------------------------------------|-----------|---|--------------------------|------------|-------------------------|--------------------------|-------------|--|-------------------------------------|--------------|---|
| 1. | This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 <i>bis</i> .1(a). | | | | | | | | | | | | | | | | | | | | | | | | |
| 2. | This REPORT consists of a total of 5 sheets, including this cover sheet. In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead. | | | | | | | | | | | | | | | | | | | | | | | | |
| 3. | <p>This report contains indications relating to the following items:</p> <table style="width: 100%;"> <tr> <td style="width: 10%; text-align: center;"><input checked="" type="checkbox"/></td> <td style="width: 30%;">Box No. I</td> <td style="width: 60%;">Basis of the report</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td style="text-align: center;"><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td style="text-align: center;"><input checked="" type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table> | <input checked="" type="checkbox"/> | Box No. I | Basis of the report | <input type="checkbox"/> | Box No. II | Priority | <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability | <input type="checkbox"/> | Box No. IV | Lack of unity of invention | <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement | <input type="checkbox"/> | Box No. VI | Certain documents cited | <input type="checkbox"/> | Box No. VII | Certain defects in the international application | <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report | | | | | | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> | Box No. II | Priority | | | | | | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability | | | | | | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention | | | | | | | | | | | | | | | | | | | | | | | |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement | | | | | | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> | Box No. VI | Certain documents cited | | | | | | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application | | | | | | | | | | | | | | | | | | | | | | | |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application | | | | | | | | | | | | | | | | | | | | | | | |
| 4. | The International Bureau will communicate this report to designated Offices in accordance with Rules 44 <i>bis</i> .3(c) and 93 <i>bis</i> .1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44 <i>bis</i> .2). | | | | | | | | | | | | | | | | | | | | | | | | |

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|---|--|
| The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland | Date of issuance of this report 18 October 2006 (18.10.2006) Authorized officer <p style="text-align: center; font-weight: bold;">Yolaine Cussac</p> |
| Facsimile No. +41 22 338 82 70 | e-mail: pt11@wipo.int |

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

TRANSLATION

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing (day/month/year) **See Form PCT/ISA/210 (sheet 2)**

Applicant's or agent's file reference

L 380-7639/zi

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/AT2004/000441

International filing date (day/month/year)

15.12.2004

Priority date (day/month/year)

13.01.2004

International Patent Classification (IPC) or both national classification and IPC

D01 F2/00, D01 F2/02

Applicant

LENZING AKTIENGESELLSCHAFT

1. ☒ This opinion contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the opinion |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/AT2004/000441

Box No. 1 Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/AT2004/000441

Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

1. Statement

Novelty (N)

Claims

YES

Claims

1-9

NO

Inventive step (IS)

Claims

YES

Claims

1-9

NO

Industrial applicability (IA)

Claims

1-9

YES

Claims

NO

2. Citations and explanations:

The subject matter of the application is not novel over the teaching of EP-A-0 494 851 (D1) or US-A-5 543 101 (D2).

The lyocell fibres disclosed in D1, examples 1 and 2, are characterized by a ratio V (FFk:FDk) of 1.46 or 1.13: that is, below the limiting value (2.2) defined in claim 1.

Claim 1 does not define the conditioning requirements for the fibres according to the invention and said requirements are only very vaguely indicated in the description (see page 4) (see also Box VIII). Therefore, said requirements cannot be considered as a distinguishing feature in evaluating novelty.

The products described in D2, examples 32-41 (cf. table 3), are also prejudicial to the novelty of the application for the same reason. The lyocell fibres described in these examples ($V < 2.2$) can be characterized as "conditioned" in the broadest sense.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/AT2004/000441

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Claim 1 does not satisfy the criterion of clarity stipulated in PCT Article 6, because the necessary conditioning requirements are not established clearly and unambiguously and therefore the proper scope of protection claimed by claim 1 is not clearly defined.

Although it follows from page 4 that FFk and FDK were determined as per the "test methods" published by BISFA, this Authority is unable to verify in detail the precise nature of these methods. Nor is it clear whether these methods in fact pertain to the required fibre conditioning, in consequence of which an objection to lack of disclosure (cf. PCT Article 5) also appears justified. Contrary to the statement on page 5 (lines under table 1), there is also no evidence that the parameter $V < 2.2$ can be achieved at a titre of ≥ 6 dtex; rather, that this parameter is achievable only at a titre of ≥ 13 dtex (see the data in table 1).

In light of this and in consideration of the teaching of the present application, fibre titre appears to be an essential element of the invention and should therefore be included in claim 1.